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10/613,202	07/03/2003	Minoru Kitamura	393032038800	4562

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EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/613,202

Applicant(s)

KITAMURA ET AL.

Examiner

Matthew B. Smithers

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/3/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed July 3, 2003 has been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In viewing claim 11 as a whole, the limitations are directed to a method for recording information based on programmed instructions. These programmed instructions are considered to be a computer program *per se*, which does not fall within one of the four statutory classes of an invention. In reviewing the specification, it is clear applicant intends for the program to be stored in physical hardware devices (such as RAM, ROM and other memories) and executed under the control of a processing unit (see page 7, lines 12-27), however, the claim does not recite the instructions are embodied within the computer readable hardware devices disclosed in the specification. Therefore, the claim is deemed non-statutory.

In viewing claim 12 as a whole, the limitations are directed to a method for reproducing information based on programmed instructions. These programmed instructions are considered to be a computer program *per se*, which does not fall within one of the four statutory classes of an invention. In reviewing the specification it is clear applicant intends for the program to be stored in physical hardware devices (such as RAM, ROM and other memories) and executed under the control of a processing unit (see page 7, lines 12-27), however, the claim does not recite the instructions are embodied within the computer readable hardware devices disclosed in the specification. Therefore, the claim is deemed non-statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,148,416 granted to Hoshino et al.

Regarding claim 6, Hoshino meets the claimed limitations as follows:

“An information reproduction apparatus for reproducing data recorded on a recording medium, said information reproduction apparatus comprising:

a first readout section (ID number decoder **51**) that reads out, from the recording medium, a medium ID (ID number signal **51a**) recorded as identification information

unique to the recording medium, an additional ID related to the medium ID being also recorded on the recording medium in attached relation to the data;

a second readout section (ID number decoder **54**) that reads out, from the recording medium, the additional ID (ID number signal **54a**) attached to the data;

a determination section (a comparator circuit **53**) that compares the medium ID and the additional ID read out by said first and second readout sections and determines whether both the medium ID and the additional ID meet a predetermined matching condition, wherein, when the additional ID attached to the data has been determined by said determination section as meeting the predetermined matching condition, the data is judged to be reproducible data." see column 5, lines 47-68; column 8, line 36 to column 9, line 25; and Figures 1 and 4.

Regarding claim 7, Hoshino meets the claimed limitations as follows:

"An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, the medium ID is recorded also as the additional ID." see

Regarding claim 6, Hoshino meets the claimed limitations as follows:

"8. An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, information obtained by encrypting the medium ID, is recorded as the additional ID.

Regarding claim 6, Hoshino meets the claimed limitations as follows:

"9. An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, the data is recorded along with the additional ID as a single data file.

Regarding claim 12, Hoshino meets the claimed limitations as follows:

“A program containing a group of instructions for causing a computer to perform an information reproduction method, said information reproduction method comprising:

a step of reading out, from the recording medium, a medium ID (ID number signal **51a**) recorded as identification information unique to the recording medium, an additional ID related to the medium ID being also recorded on the recording medium in attached relation to the data;

a step of reading out, from the recording medium, the additional ID (ID number signal **54a**) attached to the data; a step of comparing the medium ID and the additional ID read out by said steps of reading out and

determining whether both the medium ID and the additional ID meet a predetermined matching condition, wherein, when the additional ID attached to the data has been determined by said step of comparing as meeting the predetermined matching condition, the data is judged to be reproducible data.” see column 5, lines 47-68; column 8, line 36 to column 9, line 25; and Figures 1 and 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent application 20020141583 granted to Barnard et al.

Regarding claim 1, Barnard meets the claimed limitations as follows:

“An information recording apparatus comprising:

an encryption section that encrypts data to be recorded on a recording medium;  
a generation section that, on the basis of a medium ID recorded as identification information unique to the recording medium, generates an additional ID related to the medium ID;

and a recording section that records the data, encrypted by said encryption section, on the recording medium along with the additional ID.” see paragraphs [0049]; [0050]; [0051]; [0052]; and Figures 1, 4, and 5.

Regarding claim 2, Barnard meets the claimed limitations as follows:

“An information recording apparatus as claimed in claim 1 wherein said generation section uses the medium ID also as the additional ID.” see paragraph [0052]; and Figures 1, 4, and 5.

Regarding claim 3, Barnard meets the claimed limitations as follows:

“An information recording apparatus as claimed in claim 1 wherein said generation section generates the additional ID by encrypting the medium ID.” see paragraphs [0051]; [0052]; and Figures 1, 4, and 5.

Regarding claim 4, Barnard meets the claimed limitations as follows:

"An information recording apparatus as claimed in claim 1 wherein said recording section records the encrypted data and the additional ID on the recording medium as a single data file." see paragraph [0052]; and Figures 1, 4, and 5.

Regarding claim 6, Barnard meets the claimed limitations as follows:

"An information reproduction apparatus for reproducing data recorded on a recording medium, said information reproduction apparatus comprising:

a first readout section that reads out, from the recording medium, a medium ID recorded as identification information unique to the recording medium, an additional ID related to the medium ID being also recorded on the recording medium in attached relation to the data;

a second readout section that reads out, from the recording medium, the additional ID attached to the data;

a determination section that compares the medium ID and the additional ID read out by said first and second readout sections and determines whether both the medium ID and the additional ID meet a predetermined matching condition, wherein, when the additional ID attached to the data has been determined by said determination section as meeting the predetermined matching condition, the data is judged to be reproducible data." see paragraphs [0054]; [0056]; [0057]; and Figure 6.

Regarding claim 7, Barnard meets the claimed limitations as follows:

"An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, the medium ID is recorded also as the additional ID." see paragraphs [0054]; [0056]; [0057]; and Figure 6.



Regarding claim 8, Barnard meets the claimed limitations as follows:

“An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, information obtained by encrypting the medium ID, is recorded as the additional ID.” see paragraphs [0037]; [0038]; and Figure 3.

Regarding claim 9, Barnard meets the claimed limitations as follows:

“An information reproduction apparatus as claimed in claim 6 wherein, on the recording medium, the data is recorded along with the additional ID as a single data file.” see paragraphs [0037]; [0038]; and Figure 3.

Regarding claim 11, Barnard meets the claimed limitations as follows:

“A program containing a group of instructions for causing a computer to perform an information recording method, said information recording method comprising:

- a step of encrypting data to be recorded on a recording medium;
- a step of, on the basis of a medium ID recorded as identification information unique to the recording medium, generating an additional ID related to the medium ID;
- and a step of recording the data, encrypted by said step of encrypting, on the recording medium along with the additional ID.” see paragraphs [0049]; [0050]; [0051]; [0052]; and Figures 1, 4, and 5.

Regarding claim 12, Barnard meets the claimed limitations as follows:

“A program containing a group of instructions for causing a computer to perform an information reproduction method, said information reproduction method comprising:

- a step of reading out, from the recording medium, a medium ID recorded as identification information unique to the recording medium, an additional ID related to the

medium ID being also recorded on the recording medium in attached relation to the data;

a step of reading out, from the recording medium, the additional ID attached to the data; a step of comparing the medium ID and the additional ID read out by said steps of reading out and

determining whether both the medium ID and the additional ID meet a predetermined matching condition, wherein, when the additional ID attached to the data has been determined by said step of comparing as meeting the predetermined matching condition, the data is judged to be reproducible data." see paragraphs [0054]; [0056]; [0057]; and Figure 6.

### ***Allowable Subject Matter***

Claims 5 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 5 and 10, the cited prior art fails to specifically teach a display section that visually displays, as a single data file, the data and the additional ID recorded on the recording medium.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Rassool et al (US 7,043,473) discloses a system for tracking media files to determine if unauthorized duplication of the files has occurred.

B. Kambayashi et al (US 6,772,133) discloses an information recording and reproduction system for severely restricting privately copied contents under a licensing agreement.

C. Owa (US 6,687,826) discloses a method for recording data onto an optical disc.

D. Akiyama et al (US 5,805,699) discloses system for copying software onto a storage medium and controlling the copying of the software.


E. Yamagishi (US 5,379,433) discloses a method for protecting against unauthorized use of software on a recording medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Matthew B Smithers  
Primary Examiner  
Art Unit 2137